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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,233	02/14/2001	Shozo Nagano	30-5000-(4015)-Div2	3214

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EXAMINER	
IP, SIKYIN	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 01/13/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

RG

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 8/20/02 ; 10/18/02 .

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 65-82, 84-88 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 65-82, 84-88 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ Se the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Stat ment(s), PTO-1449, Paper No(s). 15

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Pat nt Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing R view, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 65-72, 74-82, and 84-88 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10287939 (abstract) or USP 6113761 to Kardokus et al (PTO-1449, claims 1-9).

4. Claim 73 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Reda (PTO-1449).

5. The cited reference(s) disclose(s) the features including the claimed Cu alloy composition and grain size. The difference between the reference(s) and the claims

are as follows: cited references do not disclose the claimed resistivity. However, the instant composition and grain size are overlapped by the cited references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

6. It is well settled that a newly discovered property does not necessarily mean the product is unobvious, since the property is inherently possessed in the prior art. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), In re Swinehart, 169 USPQ 226 (CCPA 1971), In re Skoner, et al., 186 USPQ 80, and MPEP § 2112.01. Similar process can reasonably be expected to yield products which inherently possess the same properties. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re DeBlauwe, 222 USPQ 191, and In re Wiegand, 86 USPQ 155 (CCPA 1950). A newly discovered property does not necessarily mean the product and/or process is unobvious, since this property would have been inherently possessed by the prior art. In re Best, 195 USPQ 430, 433 and In re Swinehart, 169 USPQ 226.

In re Best, 195 USPQ, 430 and MPEP 2112.01.

> "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)."

Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness. As stated in In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), "the disclosure in the prior art of any value within a claimed range is an anticipation of that range." See also, Titanium Metals Corporation of America, 227 USPQ 773 (Fed. Cir. 1985), In re Petering, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). Accordingly, a rejection under 35 USC § 102 may be applicable where the prior art discloses a value within a claimed range or where the claims and the prior art contain numerical ranges of components that touch, overlap, or are included within one another.

Response to Arguments

7. Applicant's arguments filed October 18, 2002 have been fully considered but they are not persuasive.

8. Applicants argue that alloy of Eguchi contains many additional elements. But, the instant transitional expression "comprising" does not exclude unrecited ingredient even in major amount. See Ex parte Davis et al. (POBA 1948) 80 USPQ 448 and In re Bertsch 132 F2d 1014, 56 USPQ 379 (CCPA 1942).

9. Applicants argue that alloy of Eguchi is not a physical vapor deposition target. But Eguchi suggests the copper alloy could be used for heat medium such as contacts which reads on physical vapor deposition target.

10. Applicants' argument respect to Kardokus in paragraph bridging pages 7-8 of the instant remarks is noted. But, impurities are not alloying elements. Level of purity of Cu element does not affect an amount of alloying element in the copper alloy.

11. Applicants argue that Kardokus discloses copper targets having a grain size of not more than about 50 μm which excludes the claimed less than or equal to about 30 μm. The phrase not more than about 50 μm includes a range of 0 to 30 μm which is anticipated the claimed less than or equal to about 30 μm.

12. Applicants argue that Reda does not disclose "substantially uniform microstructure and fine grain size." The recited limitations are in relative terms which are read on the by the product of cited reference.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
January 12, 2003